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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,188	09/24/2003	Jay A. Jupiter	14987.0002	4123
27890 7590 02/06/2008 STEPTOE & JOHNSON LLP 1330 CONNECTICUT AVENUE, N.W. WASHINGTON, DC 20036				
			EXAMINER SHIBRU, HELEN	
			ART UNIT 2621	PAPER NUMBER
			MAIL DATE 02/06/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/668,188	Applicant(s) JUPITER, JAY A.	
	Examiner HELEN SHIBRU	Art Unit 2621	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 January 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 6-8, 10, 15, 16 and 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 6-8, 10, 15-16 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/11/2008 has been entered.

### ***Response to Amendment***

2. The amendments, filed 12/13/2007, have been entered and made of record. Claims 2-5, 9, 11-14, and 17-21 are cancelled and claims 1, 6-8, 10, 15-16 and 22 are pending.

### ***Response to Arguments***

3. Applicant's arguments filed 12/13/2007 have been fully considered but they are not persuasive. See below.

Applicant states, “ neither neither Ishii nor Mizoguchi, alone or in combination, describes or suggests: (1) an integrated display screen configured to display a still image from the digital image file; (2) a lid including the integrated display screen on an outer surface of the lid, wherein the lid is attached to the base by a hinge and swinging between an open position and a closed position, and encloses a disc; (3) a controller, wherein the digital image file is a JPEG, GIF, TIFF or bitmap file and the controller is configured to decode the digital image file for display on the integrated display screen; and (4) a control key is configured to advance a first still image displayed on the screen to a second still image. “

In response the Examiner respectfully disagrees. Ishii discloses a portable digital image viewer comprising: a base including a disc reader configured to read a digital image file from a disc (see fig. 2, col. 3 lines 41-47 and col. 5 lines 48-55 where it discloses a head driving section and a printed circuit board to process a reproduction signal are enclosed in the casing of the main portion body 2 in fig. 2); and an integrated display screen configured to display a still image from the digital image file (see abstract, col. 7 lines 14-30 and col. 9 lines 8-20); a controller, wherein the digital image file is a JPEG, GIF, TIFF or bitmap file and the controller is configured to decode the digital image file for display on the integrated display screen (see col. 1 lines 12-20, col. 7 lines 14-30 and fig. 11); a lid attached to the base by a hinge and swinging between an open position and a closed position, and encloses a compact disc (see abstract, col. 3 lines 54-61 and col.5 lines 6-28, when the cover closes it will close the disc as well. Note that the claim does not specifically recites **during** reproduction or operation of the viewer, and therefore Ishii still meet the limitation); one or more control keys mounted on the base or on the lid and operably connected to the disc reader (see col. 3 lines 49-53, col. 10 lines 1-9, and figs 3 and 6), a control key is configured to advance a first still image displayed on the screen to a second still image (see col. 10 lines 1-9).

Mizoguchi discloses a lid including the integrated display screen on an outer surface of the lid (see col. 5 lines 45-48 and See also claim 3).

Applicant states, "The Examiner relies on "Official Notice" to provide those features that are lacking in Ishii and Mizoguchi. However, no support is given for the "Official Notice" taken."

In response the Examiner respectfully disagrees. The Examiner provided supporting prior arts in the previous office action and also stated on paragraph 7 of last office action that supporting evidences are provided on that Office action. The Examiner, hereby, given another supporting prior arts for displaying an image as a thumbnail. See paragraph 8 below.

***Claim Objections***

4. Claim 1 is objected to because of the following informalities: "a control key" on the second line from the last should be changed to "the control key". Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 6-8, 10, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishii (US Pat. No. 5,265,083) in view of Mizoguchi (US Pat. No. 6,374,040).

Regarding claim 1, Ishii discloses a portable digital image viewer comprising: a base including a disc reader configured to read a digital image file from a disc (see fig. 2, col. 3 lines 41-47 and col. 5 lines 48-55 where it discloses a head driving section and a printed circuit board to process a reproduction signal are enclosed in the casing of the main portion body 2 in fig. 2); and an integrated display screen configured to display a still image from the digital image file (see abstract, col. 7 lines 14-30 and col. 9 lines 8-20);

a controller, wherein the digital image file is a JPEG, GIF, TIFF or bitmap file and the controller is configured to decode the digital image file for display on the integrated display screen (see col. 1 lines 12-20, col. 7 lines 14-30 and fig. 11);

a lid attached to the base by a hinge and swinging between an open position and a closed position, and encloses a compact disc (see abstract, col. 3 lines 54-61 and col. 5 lines 6-28, when the cover closes it will close the disc as well. Note that the claim does not specifically recites **during** reproduction or operation of the viewer, and therefore Ishii still meet the limitation);

one or more control keys mounted on the base or on the lid and operably connected to the disc reader (see col. 3 lines 49-53, col. 10 lines 1-9, and figs 3 and 6), a control key is configured to advance a first still image displayed on the screen to a second still image (see col. 10 lines 1-9).

Claim 1 differs from Ishii in that the claim further requires a lid including the integrated display screen on an outer surface of the lid.

In the same field of endeavor Mizoguchi discloses a cover unit that rotates and detachable and the cover provided with display unit (see col. 5 lines 45-48). See also claim 3 which recites a display in the back side of the frame. Mizoguchi further discloses the lid is attached to the base by a hinge and swinging between an open position and a closed position, and encloses a compact disc (see claim 3, when the cover closes it will close the disc as well). Therefore in light of the teaching in Mizoguchi it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ishii by providing a display on an outer surface of the lid in order to view the image in the back.

Regarding claim 6, Ishii discloses the integrated display screen is a color screen (see col. 7 lines 14-30).

Regarding claim 7, Ishii discloses the color screen has a diagonal dimension of no more than 6 inches (see col. 5 lines 36-41, where it shows the screen is 4 inches).

Regarding claim 8, Ishii discloses the disc reader includes a laser that operates at a wavelength longer than 750 nm (see col. 8 lines 10-28 where it teaches a semiconductor laser is used, and it is inherent that semiconductor laser emits wavelength above 750nm).

Regarding claim 10, the limitation of claim 10 can be found in claims 1 and 8. Therefore claim 10 is analyzed and rejected for the same reason as discussed in claims 1 and 8 above.

Regarding claim 15, Ishii discloses the viewer is configured to display a digital image at full size on the integrated display screen (see col. 7 lines 14-30).

7. Claims 16 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishii in view of Mizoguchi (US Pat. No. 6,374,040) and further in view of Official Notice.

Regarding claim 16, Ishii discloses a portable digital image viewer comprising: a base including a disc reader configured to read a digital image file from a compact disc (see rejection of claim 1 above); and an integrated display screen configured to display a still image from the digital image file (see rejection of claim 1 above);

a lid including the integrated display screen, the lid being attached to the base by a hinge and swinging between an open position and a closed position, wherein the lid when in the closed position encloses the disc (see abstract, col. 3 lines 54-61 and col.5 lines 6-28, when the cover closes it will close the disc as well. Note that the claim does not specifically recites **during** reproduction or operation of the viewer, and therefore Ishii still meet the limitation); and

one or more control keys mounted on the base or on the lid and operably connected to the disc reader (see col. 3 lines 49-53, col. 10 lines 1-9, and figs 3 and 6), the viewer is configured to display a still image generated from a digital image at full size on the integrated display screen (see col. 7 lines 14-30).

Claim 16 differs from the proposed combination in that the claim further requires an input port for a digital memory card configured to read a digital image file from a digital memory card. Although Ishii does not specifically disclose in the detailed description, Ishii discloses using a joy card in the conventional CD\_I system.

Official Notice is taken that using a digital memory card in a portable image viewer is well known in the art in order to save data. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to include an input port for a digital memory card in order to connect a removable memory.

Claim 16 further differs from the proposed combination in that the claim further requires to display the one or more images as a thumbnail.

Official Notice is taken that displaying still image as a thumbnail is well known in the art in order to represent the image in smaller size. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to display a thumbnail image for the users to search data.

Regarding claim 22, Ishii discloses the disc reader includes a laser that operates at a wavelength longer than 750 nm (see col. 8 lines 10-28 where it teaches a semiconductor laser is used, and it is inherent that semiconductor laser emits wavelength above 750nm).

### ***Conclusion***



8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Aruga et al. (US Pat. No. 6,429,896) disclose digital memory card.

Yano et al. (US Pat. PG Pub 2002/0167883 A1) discloses digital memory card.

Kato et al. (US Pat. No. 5,712,949) disclose display on the outer surface of the lid.

Stewart et al. (US PG PUB 2002/0071246 a1) disclose display on the outer surface of the lid.

Mori et al. (US Pat. No. 7,228,061) discloses displaying still image as a thumbnail (see claim 8 for example).

Kotani et al. (US PG PUB 2002/0059215 A1) discloses displaying still image as a thumbnail (see paragraph 0057 for example).

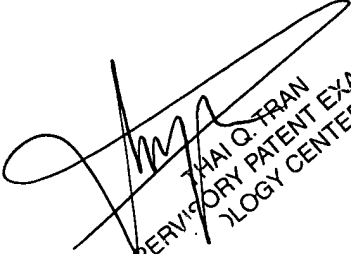
Sakuyama et al (US Pat. No. 7,228,000) teaches displaying still image as a thumbnail.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HELEN SHIBRU whose telephone number is (571) 272-7329. The examiner can normally be reached on M-F, 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THAI Q. TRAN can be reached on (571) 272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Helen Shibru  
January 26, 2008

  
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